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REMARKS

Applicants respectfully request entry of this Amendment and reconsideration of this application on its merits. Applicants also respectfully request a one month extension of time. The Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees.

I. General Remarks Regarding the Content of this Amendment

Upon entry of this Amendment, claims 1-6, 11-29, 31-46, 48, 49, and 65-67 will remain pending in this application.

Applicants have amended claims 1, 2, 11-13, 18-20, 23-25, 27, 28, 31-33, 35-43, 48, 49, and 65. Claims 7-10, 30, 47, and 50-64 have been canceled. Claims 50-64 were withdrawn as being drawn to a non-elected invention. No new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

II. The Anticipation Rejections under 35 U.S.C. § 102 (b) Should be Withdrawn Because Applicants' Claims Patentably Distinguish from the Cited Art

In the September 12, 2006, Office Action, the Examiner rejected claims 1-11, 13, 14, 16-24, 26-35, 37-49, 65, and 67 in this application under 35 U.S.C. § 102 (b) as allegedly anticipated by Joha, U.S. Patent No. 1,888,172 (hereinafter "Joha"). For a claim to be anticipated by a prior art reference, the reference must contain each and every element of the claimed invention. *See, The Manual of Patent Examining Procedure*, § 2131. If a claim contains an element that is not disclosed in the prior art reference, then a rejection of that claim as being anticipated by the reference is improper and should be withdrawn. *Id.* As will be demonstrated below, Joha fails to anticipate Applicants' claimed invention.

Independent claims 1, 20, 28, 41, and 65, as amended, contain at least one element that is not found in the Joha reference. The Joha reference teaches "an improved form of knitted blank, and...also provide[s] means for utilizing such blanks to form knitted shoes." *See* Joha, at col. 1, lines 18-21. Another object of the Joha patent is to "provide means for reinforcing the heel and sole portions of [the] footwear to produce shoes having...continuously knitted uppers..." *Id.* at lines 42-46. Joha fails to disclose that the upper incorporates a single type of textile having a plurality of knit constructions

as recited in claims 1, 28, and 41. Joha also fails to teach a weft-knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element, as recited in claim 20. Nor does Joha have a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties, as recited in claim 65. Furthermore, claims 2-6, 13, 14, 16-19, 21-24, 26, 27, 29, 31-35, 37-49 and 67 depend from one of claims 1, 20, 28, 41, and 65, and thus are not anticipated by the Joha reference for at least the same reasons. Claims 7-10 and 30 have been canceled by this Amendment, which renders the rejection of these claims moot. Applicants respectfully request that the Office withdraw the rejection of claims 1-11, 13, 14, 16-24, 26-35, 37-49, 65, and 67 under 35 U.S.C. § 102 (b) based on the Joha patent.

In the September 12, 2006, Office Action, the Office rejected claims 1, 2, 7-11, 13-24, 26, 27, 41-43, 47-49, and 65-67 in this application under 35 U.S.C. § 102 (b) as allegedly anticipated by Throneburg, U.S. Patent No. 6,308,438 (hereinafter "Throneburg"). Independent claims 1, 20, 41, and 65, as amended, contain at least one element that is not found in the Throneburg reference. The Throneburg reference teaches a slipper sock with a knitted upper having a thickened ball portion and a thickened heel portion in the footbed. Throneburg fails to disclose that the upper incorporates a single type of textile having a plurality of knit constructions, as recited in claims 1 and 41. Nor does Throneburg teach a weft-knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element, as recited in claim 20. Lastly, Throneburg fails to teach an upper having two different unitary constructions, as recited in claim 65. Although Throneburg teaches that the ball portion and heel portion of the footbed are "thickened," the construction of that knitting is not of a different construction than other areas of the upper, as recited in Applicants' claims. Furthermore, claims 2, 11, 13-19, 21-24, 26, 27, 42, 43, 47-49, 66, and 67 depend from one of claims 1, 20, 41, and 65, and thus are not anticipated by the Throneburg reference for at least the same reasons. Claims 7-10 have been canceled by this Amendment, which renders the rejection of these claims moot. Applicants respectfully request that the Office withdraw the rejection of claims 1, 2, 7-11, 13-24, 26, 27, 41-43, 47-49, and 65-67 under 35 U.S.C. § 102 (b) based on Throneburg.

III. The Obviousness Rejections under 35 U.S.C. § 103 (a) Should be Withdrawn Because Applicants' Claims Patentably Distinguish from the Cited Art

In the September 12, 2006, Office Action, the Office rejected claims 12, 25, and 36 in this application under 35 U.S.C. § 103 (a) as being obvious over Joha in view of Fay, Sr., U.S. Patent No. 5,746,013 (hereinafter "Fay"). The Office bears the burden of proving a *prima facie* case of obviousness under 35 U.S.C. § 103 (a). *See, The Manual of Patent Examining Procedure*, § 2142. When an obviousness rejection is based on multiple references, the Examiner must identify a suggestion or motivation to combine the teachings of the references, which is viewed from the perspective of one skilled in the art or from the express or inherent disclosures found within the references. *Id.* Further, one skilled in the art must objectively have a reasonable expectation of success when the teachings of the references are combined and are considered as a whole. *Id.* Additionally, *every* element of the claimed invention must be taught or suggested by the reference to render it *prima facie* obvious. *Id.*

Here, claims 12 and 36, through their respective parent claims, recite that the weft-knitted textile element incorporates a single type of textile having a plurality of knit constructions, and claim 25, through its parent claim, recites a weft-knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element. As noted above, the Joha reference fails to disclose a textile element having a plurality of knit constructions nor does it disclose a weft-knitted textile element having first and second areas that each has a different stitch configuration to impart different properties to each area. The Fay reference fails to remedy these deficiencies of Joha, and indeed, the Office does not rely on Fay for these features. Rather, the Examiner relies upon the Fay reference exclusively to disclose an upper having three layers. *See* September 29, 2006, Office Action at page 4. Therefore, the combination of the Joha patent and the Fay patent fails to teach at least one element of the claimed invention. Applicants respectfully request that the Office withdraw the rejection of claims 12, 25, and 36 under 35 U.S.C. § 103 (a) based on the combination of Joha and Fay for at least these reasons.

In the September 12, 2006, Office Action, the Office rejected claims 12 and 25 in this application under 35 U.S.C. § 103 (a) as being obvious over Throneburg in view of Fay. As discussed above, the Office must identify each and every element of the claimed invention within the combined references upon which the Examiner relied to reject a claim as being obvious. Also discussed above, Throneburg fails to teach that the upper incorporates a single type of textile having a plurality of knit constructions, as recited in claim 12 (via its dependence from claim 1). Nor does Throneburg teach a weft-knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element, as recited in claim 25 (via its dependence from claim 20). The Fay reference fails to remedy these deficiencies in Throneburg, and indeed, the Office does not rely upon Fay for these features. Rather, the Examiner exclusively relies upon the Fay reference to teach that an upper may have three layers. *See* September 29, 2006, Office Action, at page 4. Therefore, the combination of Throneburg and Fay fails to teach at least one element of the claimed invention. Applicants respectfully request that the Office withdraw the rejection of claims 12 and 25 under 35 U.S.C. § 103 (a) based on the combination of Throneburg and Fay for at least these reasons.

IV. Conclusion

For the reasons described above, Applicants respectfully submit that this Amendment renders moot the various grounds of rejection raised in the September 29, 2006, Office Action. Withdrawal of these rejections is respectfully requested.

Nothing in this Amendment should be construed as an admission that Applicants agree with or acquiesce in the various grounds of rejection raised by the Office in the September 29, 2006, Office Action. Rather, by this Amendment, Applicants have presented various claim amendments and canceled certain claims in an effort to expedite prosecution and to facilitate the immediate allowance of this application. The claim changes made in this Amendment are presented without prejudice or disclaimer, and Applicants reserve all rights with respect to the originally and/or previously claimed subject matter, including the right to pursue claims of the same or similar scope in the future (*e.g.*, in a continuing application).

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or to place the application in condition for allowance, she is invited to contact the undersigned attorney.

If any fees are due in connection with this Amendment, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pendency of this application.

All rejections having been fully addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

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